

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TO: Commissioner for Patents

Virginia 22313-1450

5

APPEAL BRIEF

10 ATTEN: Board of Patent Appeals and Interferences

The following brief is submitted in connection to the Action Letter mailed July 9 2008.

This brief is NOT accompanied by the fee US\$ 255 as the previous Appeal Fee has not
15 been spent given the Examiner had reopened examination following the last Appeal Brief
dated Jan 21 2008.

Thank you.

20

Yours truly,

A handwritten signature in black ink, appearing to be 'KH' followed by a long horizontal stroke.

25 Appellant/Applicant
023336
24 AUG, 2008

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

REAL PARTY IN INTEREST

5

The real party in interest is the Applicant/Appellant, Khai Hee Kwan.

RELATED APPEALS AND INTERFERENCES

10

None

15

STATUS OF CLAIMS

20

The examiner states that claims 13-14,26, 33-36, 38-46 and 48-52 are pending in said Action Letter July 9 2008. This is respectfully disagreed. Claims pending as filed July 23 2007 are listed as 13,14,26,33,34,35,36,38,39,40,41,43,44,45,46,48,49,50,51,52. A copy of said claims are contained in the APPENDIX .

25

STATUS OF AMENDMENTS

No amendment has been filed since last Appeal Brief dated Jan 21 2008.

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

SUMMARY OF THE CLAIMED SUBJECT MATTER

- 5 This invention was filed Sept 13, 1999 and claims foreign application claiming priority based on an earlier filing date Aug 11, 1999 in Australia.

A. Claim 13 – Independent Method

- 10 The present invention features a computerized network method for allowing payer to credit funds to a payee (page 19, lines 14-15 and page 21 line 14-15 of Specification) using funds previously deposited from a prepaid card (page 10 line 4-10 and page 19 lines 7-12 of Specification) using the internet (page 2 line 5 of Specification) as the network. The process is instantaneous (page 3 line 15 of Specification). The payer has to
15 provide his account identifier, password, amount and the payee's account identifier (page 21, line 8-15 of Specification). The account's identifier are user created. (See Original Claim 3 of the Specification –“...otherwise will ask the user to set up an account as an alternative option;”). The funds are transferred without interacting with said payee and independently of said prepaid card (using double entry method - See page 19, lines 13-18
20 of specification).

A1. Claim 34 – Independent System

- 25 Claims 34 is an independent claim describing an internet system having linked to the Internet (Fig 1 at 15) to a host server (Fig 1 at 60) having a database (Fig 1 at 85) to transfer stored funds (see page 13 lines 23 - database is programmable) in any currencies under payer's control (page 19, lines 13-18 and page 21 line 10-15 of Specification),
30 wherein said server having a processor (in Host server – Fig 1 at 60) to execute program codes stored in a computer storage medium. (in Host Server - Page 13 lines 22 to Page 14 line 5 and Page 18 lines 5- central processor process information)

The system allows payer to credit funds to a payee (page 19, lines 14-15 and page 21 line 14-15 of Specification) using funds previously deposited from a prepaid card (page 10 line 4-10 and page 19 lines 7-12 of Specification) using the internet (page 2 line 5 of Specification) as the network. The process is instantaneous (page 3 line 15 of Specification). The payer has to provide his account identifier, password, amount and the payee's account identifier (page 21, line 8-15 of Specification). The account's identifier are user created. (See Original Claim 3 of the Specification –“...otherwise will ask the user to set up an account as an alternative option;”). The funds are transferred without interacting with said payee and independently of said prepaid card (using double entry method - See page 19, lines 13-18 of specification).

A2. Claim 39 – Independent article of manufacture

Claims 39 is an independent claims describing an article of manufacture. (Program – See Page 2 line 4) Computer executable software code (Page 16 line 7 - line 8 – C+) stored on a computer readable storage medium (in Host Computer in Fig 1 at 60), said codes when executed causing said host server to perform. In essence, the codes when executed cause the host computer to perform the same way as method claim 34 above to allow payer to credit funds to a payee (page 19, lines 14-15 and page 21 line 14-15 of Specification) using funds previously deposited from a prepaid card (page 10 line 4-10 and page 19 lines 7-12 of Specification) using the internet (page 7 line 4-6 of Specification) as the network.

The process is instantaneous (page 3 line 15 of Specification). The payer has to provide his account identifier, password, amount and the payee's account identifier (page 21, line 8-15 of Specification). The account identifier is user created. (See Original Claim 3 of the Specification –“...otherwise will ask the user to set up an account as an alternative option;”). The funds are transferred without interacting with said payee and

independently of said prepaid card (using double entry method - See page 19, lines 13-18 of specification).

5 B. Claim 48 – Independent Method

The present invention features a computerized method that transfer funds which are deposited without using said payer's bank account (See Page 5 line 4-6 and page 18 line 14 of specification). The transferred is between two different individuals having user
10 created account identifier (See Original Claim 3 where user is given the option to create his own account--"...otherwise will ask the user to set up an account as an alternative option;") being different from source of funds. (See Page 19 lines 7-12 of Specification – using a prepaid card) The transfer requires said account identifier to be submitted for verification (page 24, line 8 of Specification) and said transfer is instantaneously (See
15 Page 3 line 15 of Specification) without interacting with source of funds and payee (using double entry method See Page 19, lines 13-18 of specification).

20 B1. Claim 49 – Independent System

Claims 49 is independent system claim. Its structure comprise of a host server (Fig 1 at 60) having a database (Fig 1 at 85) to transfer stored funds (see page 13 lines 23- the database is programmable), wherein said server having a processor (See host server – Fig
25 1 at 60, Page 18 lines 5- central processor process information) to execute program codes (page 16 lines 7-8) stored in a computer storage medium (See host server in Fig 1 at 60) ; and wherein the program codes are executed causing host server to perform the steps in Claim 48 which are already described above.

30

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

5 A. Whether the examiner's Claim rejection under 35 USC 101 at page 2 of Action Letter is sustainable ?

 B. Whether the examiner's Claim rejection under 35 USC 112 (2nd Para) at page 3 of Action Letter is sustainable ?

10

 C. Whether the examiner's Claim rejection under 35 USC 103(a) at page 4-7 is sustainable ?

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

ARGUMENT

- 5 The examiner had reopened prosecution in Action Letter mailed July 9 2008. The applicant had considered the issues from both the current Action Letter and previous Final Action Letter mailed Oct 9 2007 and summarized them as follows: .

Appellant's Comments	Action Letter dated July 9 2008	Final Action Letter Oct 9 2007
	Nil	Response to Arguments
	Nil	Claims Interpretation
	Nil	35 USC 112 Para 1
Involves the same claims previously examined but rephrased differently.	35 USC 112 Para 2	35 USC 112 Para 2
	Nil	35 USC 102 (Katz)
NEW	35 USC 101	
NEW	35 USC 103 (using Katz & Walker). However only claims 26,36,41 uses the combination.	

- 10 In view of the above, it must be admitted that the examiner conceded on the “response to arguments, claims interpretation and 35 USC 112 Para 1” rejection as in Final Action Letter mailed Oct 9 2007.

- 15 A. Whether the examiner's Claim rejection under 35 USC 101 at page 2 is of Action Letter is sustainable ?

The examiner stated that Claims 13-14 and 26 are not tied to any class (such as a particular apparatus). The examiner considered that even though the preambles of Claims

- 20 13-14 recite the aspect of a host server, the bodies of the claims do not recite such apparatus. And the examiner concluded that these methods are not patent eligible processes under 35 USC 101.

The appellant respectfully disagrees. The examiner had not shown any case law that shows a recital of apparatus in the preamble is to be ignored under 35 USC 101. In fact, it is trite law that the preamble should be read together if it to give life, meaning and vitality to the claim as quoted “It is well settled that if the body of the claim sets out the complete invention, and the preamble is not necessary to give life, meaning and vitality to the claim, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.” Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1310, 64 USPQ2d 1832, 1837 (Fed. Cir. 2002). Also, a preamble limits the claimed invention if it recites essential structure or steps, or if it is “necessary to give life, meaning, and vitality” to the claim. Catalina Mktg., 289 F.3d at 808, 62 USPQ2d at 1784 (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)).

Therefore applying both case law, then it is clear that the apparatus in the preamble could be read to limit to defeat this 35 USC 101 rejection.

B. Whether the examiner’s Claim rejection under 35 USC 112 (2nd Para) at page 3 of Action Letter is sustainable ?

Firstly the term ‘R’ is a factor related to flexibility in currency stored refers to asking whether the user wish to store in local or foreign currency, if it is local then use variable ‘1’ else the currency factor/exchange. Therefore there is no difficulty in interpreting a yes (use ‘1’) or no answer (use currency exchange) and the example of $Y=X+2$ given by the examiner is not appropriate for this factor. Further it is also necessary to reason from one ordinary skilled in the art that such claimed language in light of the supporting specification would not be able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. (Ex parte Wu, 10 USPQ 2d 2031, 2033(BPAI 1989)). The appellant respectfully submits the examiner had not discharge this initial burden.

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

C. Whether the examiner's Claim rejection under 35 USC 103(a) at page 4-7 is sustainable ?

Claim rejection under 35 USC 103(a).

5 (SUMMARY)

The examiner's assertions are respectfully rejected.

The examiner provided the prior art by Katz (US Patent 6424706) which relates to telecommunication-time (unit-minute) made transferable between subscribers and subscribers or non-subscribers. See abstract which states "A system and method for
10 accessing the value associated with a pre-purchased amount of telecommunication-time for making telephone calls and for uses other than making telephone calls is provided".

There is no mentioned by Katz of transferring "stored funds". The examiner fails to show telecommunication-time (unit-minute) is inherently found to be FUNDS to one skilled in
15 the art of telecommunication. The applicant submits there is a clear division alluding to this given Katz teaches having to convert the unit-minute to funds at a redemption office 202 or bank 221. If FUNDS are inherently as unit-minute then why is there a need to convert ?

20 It is also pertinent to note that Katz uses a prepaid CALLING card and not a prepaid card, the difference here is that a prepaid calling card is for making telephone calls while a prepaid card is to make purchases. There is nothing in the applicant's specification dealing with telecommunication which enable one skilled in the art to read a prepaid

CASH card as a prepaid calling card and hence it would not be reasonable to read into the claims.

- Even if a prepaid card can be used to make a telephone call (ie as a calling card), it does not mean a prepaid calling card in Katz could be used for purchases unless it is first
- 5 converted to unit-minute and then converted to funds at office 202 or bank 221, a two stages process. In fact this is the essence of Katz's invention which is to make use of unused prepaid unit-minutes for purchases or other services other than making a phone call but this is not the same as saying a prepaid calling card can be used as funds directly.
- 10 Even if prepaid card is broad enough to include prepaid calling card (which is denied), the fact is that in this claimed invention at claim 13,34,39 the key element is "said stored funds is deposited from a prepaid card" and as submitted above, a prepaid calling card in Katz is not capable of depositing funds as it could only provide unit-minutes for telecommunication. In Katz, funds are only recognized when unit-minutes leave the
- 15 system and enter into some financial network or at the redemption office and not at the time of depositing.

- Lastly, all the obviousness rejection should be withdrawn. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or
- 20 motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). Save for Claims 26, 36,41, the examiner had not provided any motivation and therefore such rejection is unsafe.

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Claim 13,34,39

The following Table A summarized the main differences between Katz and the claimed invention 13,34,39.

Items	Claimed Elements	Katz	Comments
1	a host server having a database to transfer stored funds (preamble)	uses a computer 343 having its own database 344 and a prepaid telco computer 172 also having its own database 173 of prepaid minute accounts stored. (See Fig 3A)	Katz's requires its unit-minute system 340 to interface with prepaid platform 170 each having their own computer cum databases. This means it needs 2 host servers (343,172) and 2 databases (173, 344) in contrast to claimed invention with database to transfer stored funds. Nothing in Katz teaches its database is capable to transfer stored funds.
2	said stored funds is deposited from a prepaid card <u>into an account linked to an user created identifier</u>	prepaid calling card or credit card or bank account are used to deposit or <u>prepaid stored value account such as telephone call minute accounts</u> (Col 4 lines 40-44)	Katz's cards can only depositing unit-minutes not <u>funds</u> . Credit cards/bank accounts are used to buy unit-minutes which are then deposit. Examiner made no mentioned of <u>user created identifier missing in Katz</u> .

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

3	said transfer is made without interacting with said payee	In a preferred embodiment, after unit-minute transactions are completed, the system <u>notifies</u> both parties of the success of the transaction, and provides a unique transaction identifier that can be used for future reference and validation. (Col 8 line 48-50)	Since Katz has to provide an unique transaction identifier then there must be communication (ie interaction). The examiner used Col 8 lines 63-64 which deals with the hardware to make transfer but <u>no mention of without interaction with payee.</u>
4	independently of said prepaid card	using a smart card adapter in association with wireless device or PDA (Col 21, line 50-55)	using the prepaid card as a store value which is contrary to storing funds in database
5	upon authenticating the payee's account identifier, instantly crediting the fund to the payee's account upon determining balance in the database associated with the payer account identifier and password is more than the fund for transfer;	Examiner provided Item F in page 5 of Action Letter.	No <u>instantly</u> crediting funds. As mentioned Katz deals with unit-minute, there is a need to convert and then to transfer to banking institutions etc. The action of relying on third party to carry the last leg of the transfer must necessarily means it is not instantly.
6	<u>instantly</u> debiting the balance associated with the payer's account identifier and password in the database with said fund transferred to said payee's account;	No mentioned by Katz or Examiner	No instantly.

Discussion on Item 1 of Table A

The examiner provided item A and C at page 4 of Action Letter.

Fig 3A of Katz provides the entire system interconnection to satisfy a transfer of unit-minutes and linking to a financial network 223 and 365 to complete the conversion to

- 5 funds (two stage process). As noted, Katz provides United Minute System (UMS) 340 which is adapted to interface with prepaid platform 170. As taught by Katz the 'transfer' is done as explained at col 9 line 5 to line 25 and the applicant quotes "For instance, in a preferred embodiment, the present invention leverages existing prepaid minute accounts stored within a prepaid telephone platform, rather than replacing them with the
- 10 invention's own minute accounts. Therefore, in order to perform the necessary unit-minute transactions, the unit-minute system must have read and write access to these accounts, and a converter for converting the existing prepaid minutes of the prepaid platform to the unit-minutes of the invention. Furthermore, any changes to data fields of the prepaid platform's minute account that are accessed by both the prepaid platform and
- 15 unit-minute system must be made using a method that guarantees transactional integrity. Such access may be accomplished by integrating the transaction processing subsystem of the unit-minute system's computer system with the transaction processing subsystem of the prepaid platform by an adapter. Each system's transaction processing subsystem will in turn communicate with its respective database as needed to update any changed fields.
- 20 Once the two systems are integrated in such a fashion, changes made by either system to such shared fields will be communicated to both systems in a transactionally safe and reliable fashion." (underlined mine)

From this teaching (Fig 3A) it is shown more than one host (UMS 340 and Prepaid

- 25 Platform 170) and more than one database (173 and 344) are needed to effect a transfer of unit-minutes. Therefore at the material time of any 'transfer' it is NOT funds that is being transferred. It is also clear that by itself UMS 340 by itself cannot transfer any unit-

minute as it depends on prepaid minutes from another database 173 (telco) to synchronize to its own database 344. This “interface” is said to be an advantage of the Katz’s system having its own database as able to leverage (something like piggy-back) on the telco’s prepaid database. The transaction process is for Katz’ system by accessing the telco’s prepaid database to read/write its data (being unit-minutes). This probably means the telco by itself could not do any transaction between accounts as it needed an external (Katz) system to manage this, otherwise the logically question is that why allow a third party to do this ? Then it is not difficult to conclude the state of the art in Katz time is that telco is not capable of doing any transaction between accounts unless aided by third party. Then this teaching clearly does not meet this claimed invention, as this claimed invention has no interface between two databases from two different host servers belonging to two different entities. There is not even a telco database as claimed. Even if there are more than ONE host server and hence more than ONE database, they are not ‘interfacing’ two separate entities (ie telco and Katz’s UMS).

Discussion on Item 2 of Table A

Katz teaches using a prepaid calling card to deposit unit-minutes or a credit card (col 6 line 33) or bank account (col 6 line 44) and uses a stored value accounts such as telephone call minute account (col 4 line 43). However, these facilities do not deposit FUNDS rather they are deposited as prepaid minutes in the prepaid platform 173 and unit-minutes in the database 344 of UMS 340 (See Fig 3A). Funds from these facilities are used to purchase unit-minutes but it does not necessarily shows depositing funds. It is well known that a telco must uses unit-minutes as a measurement of its service system. The main function of a telecommunication service provider is to provide telecommunication services and therefore its unit of measurement must be in minutes and

not funds. Further, Katz's invention is to adapt any unused unit-minutes to do something else other than making a phone call without modifying the function of a telco in contrast with this invention where it is designed to transfer funds deposited by a prepaid card. This clearly teaches unit-minutes are stored at all material time instead of FUNDS.

5

The examiner provided at item G page 5 "The account is which funds are being transferred from is prepaid stored value account" and supported this by col 4, line 42 which also states "...such as telephone call minute accounts containing telecommunication-time units, over a network is provided". The examiner provided no reasoning to show how one skilled in the art of telecommunication must inherently see call minutes accounts containing telecommunication-time units must necessarily be stored funds. It is submitted that because the examiner fails to show that a prepaid stored value account must necessary store funds in a telecommunication service provider, inherency is not found. Furthermore, if funds is stored instead of telecommunication-time units, then this would contradict the example given by Katz for the need to convert to funds through the financial network ('conversion').

10

15

The examiner also failed to show "into an account linked to an user created identifier". It is clear that the subscriber in Katz is given a telephone number as the identifier (Katz Col 7 line 6). It is submitted it is not known that this telephone number is an user created identifier in the telecommunication art.

20

25

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Discussion on Item 3 of Table A

As mentioned in Katz because the first stage of the transfer concerns unit-minutes, then it is necessary to redeem to money/funds. Katz clearly provides “transfer” to mean
5 transferring of unit-minutes. For example, at Col 21, line 9-10, as is written “ Given the ability to transfer and redeem unit-minutes...”.

In reference to “said transfer is made without interacting with said payee” this is not meet by Katz as it is shown after a payer has transferred his unit-minute then the payee has to
10 be notified (unique identifier) to redeem the converted unit-minutes using said unique identifier (Col 8 line 47-51) . This notification of said identifier for that transaction which requires interacting with a party obviously does not meet this claimed invention’s element in item 3. If the payee is not a subscriber, then payer will have to inform them directly (col 19, line 34-40).

15

The examiner in reply only shows “ The prior art invention makes an electronic funds transfer “ and provided col 8, lines 63-64. (See item H at page 5) The evidence only shows Katz’s invention is connected to financial networks such as ATM/POS, FedWire and CHIPS which is capable of making an electronic funds transfer but there is no
20 evidence here to show without interacting with payee. In fact, these networks as shown ATM/POS (233) and Intrabank network (365) in Fig 3B would require some interaction between the different member banks of the network which collectively are payers and payees on behalf of their customers such as in ACH or through SWIFT.

The examiner concluded by stating “therefore the actual transfer is made without any user interaction and regardless of the origination of source funds”. The applicant considers this conclusion to be limited to the financial network as opposed to Katz’s telecommunication network which is not capable of transferring funds in view to “actual transfer” to denote transfer of funds. If this is the case then it should also be noted this claimed invention requires such transfer to be made “INSTANTLY” by crediting and debiting the nominated accounts. It is well known that ACH/SWIFT/CHIPS (collectively financial network) is an overnight batch process (Col 10 line 10-15). The word “daily” would appear to be longer than instantly.

If the applicant is wrong (which is denied) and actual transfer is referencing transfer of unit-minutes then it is clear Katz teaches interacting with payee as above (providing reference to redeem – see Col 8 line 47-51) and as argued transferring unit-minutes does not meet the requirement for transfer of funds in view of one skilled in the art of telecommunication.

As for redemption, even if these financial networks managed to avoid interacting with the final payee during the inter-bank transfer (ACH/SWIFT/CHIPS networks), it is crystal clear that whenever there is a redemption it must necessarily involve interacting with the payee since by definition, a redemption is an act done by said payee (For example see Fig 5A at BOX 504 providing redemption password to employee wherein password was from sender BOX 503). In Fig 6 where a subscriber is redeeming his own unit-minute (ie making himself both as payer and payee) via the financial network then it clearly shows him interacting by firstly inserting his ATM card.

Even if the applicant is wrong above (which is denied), the logical conclusion is that the examiner's sole reliance on these financial networks to show there is no interaction is selective reasoning as it ignores Katz's collective teaching. As mentioned by Katz, these financial networks interfaced with his telecommunication entities (not isolated) and his

- 5 UMC to allow the redemption part of the process since cash is needed. There could not be ANY transfer within the financial network had it not been the initial unit-minutes transfer first which in-between interacted by sending out notification (see col 8 line 48-50) and in order to convert them, said financial networks were chosen to cover the redemption of its unit-minutes. It is also undisputed that there is also interaction during redemption phase
- 10 by the payee and a need to interface with telco's computer/database. So in totality, Katz taught interaction and hence it is flawed to select only the financial network (which is part of the overall network) to reveal without interacting. Even if this could stand, such financial network (say ACH) is not able to satisfy the "instantly" element in effecting a transfer. Hence, either way it is clear if "transfer is made without interacting with said
- 15 payee" and "funds" are met using the financial network alone, then "instantly" is not. On the other hand, if "instantly" is met by using Katz's telecommunication database, then "transfer is made without interacting with said payee" and "funds" are not meet.

Discussion on Item 5 & 6 of Table A

20

In the claimed invention, the funds need to debit/credit funds instantly and it is clear from the forgoing discussion this is not found in Katz. In fact, Katz merely transfer the unit-minutes follow by notification to the payee which is then followed by redemption through the financial network. This could not be instantly done to reach the stage of FUNDS.

25

In conclusion, given the above items 1,2,3,5,6 are not found in Katz and contradicts item 4 (where a smart card is used), the applicant respectfully submits obviousness rejection is not appropriate. It is also not appropriate given that the examiner had failed to show why one skilled in the art would modify from transferring unit minutes to funds within a telecommunication network. The examiner should and ought to explain why one skilled in the art would also be motivated to include an account linked to an user created identifier. Clearly this obviousness rejection is premature and should be withdrawn. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Claims 14, 35,40

These claims deal with storing and linking card amount to an user account identifier. The examiner only made mentioned of “whereby upon completion of storing and linking said prepaid card is valueless” as page 5 item I. The examiner provided col 2 lines 25-26, which provides “First, subscriber 100 inputs their unique subscriber ID, which in the case of long distance prepaid systems is typically a temporary identifier, printed on the card itself and good until all of the minutes associated with the card are used up.”

Understandably this evidence is referring to long distance prepaid cards and the identifier is good until all minutes associated with the card is used up which the applicant does not dispute. However, how is this connected to storing and linking card amount to an user account identifier which by the way is NOT a temporary identifier ? In this claimed invention, a prepaid card having an amount and identifier is stored and linked to an user account identifier which on completion, the said card is valueless and not by using up the

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

minutes associated in long distance calls. If there is a difference between using up the funds in a prepaid card rendering the card valueless (examiner's suggestion) to storing and linking those funds to an user account identifier as claimed thereby rendering said card valueless. The user also has to create his own identifier in the process which
5 obviously has to be permanent to distinguish the identifier on the card.

Furthermore, the amount in this claimed invention is stored by calculating its face amount and linking it to user created identifier (NOT card identifier). At the end the stored amount is still available but only through the user identifier and NOT card identifier.
10 Hence, the card is valueless. The applicant respectfully submits Katz fails to teach this and hence the claims should be allowed.

No other rejections of the other elements in claims 14,35,40 were made by the examiner. To reject the claims, ALL elements in the claims must be shown by the examiner which
15 is not performed in this instance and the applicant could only conclude this failure by the examiner must mean the other elements are not found in Katz. Furthermore without a motivation the examiner had not even raise the threshold of prima facie. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co.
20 v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Claims 26, 36,41

25

The examiner says that Walker teaches a system that randomly adds value to some gift certificates, thereby increasing both the real and apparent value of the certificate both to the buyer and the redeemer. (Action Letter page 6-7).

The Appellant respectfully submits that this claimed invention is NOT about randomness, its formulation and calculated values are precise and not in any way random. While it is not doubted one skilled in the art could pursue in whatever ways with a reasonable
5 expectation of success, this by itself could not be motivated when the entire foundation is wrong. The examiner had not explained how a randomness could provide the motivation to morph into a complicated formulation which depends on user input to reach a final value to STORE the funds as contrast to increasing the value albeit randomly of gift certificate's value. There is a clear failure of connection between storing value from a
10 prepaid card for later day use by a formula to teaching of randomly increasing the value of gift certificates. The appellant respectfully disagree with the examiner's which put no reason at all how Walker's gift certificates would add to Katz's teaching when it is clear Katz's is only interested in unit minutes accounts rather than monetary funds. Katz's need unit minutes as it was designed to access the telco's database which uses unit minutes as
15 a measure of its service. Therefore, it is clear the examiner had failed to show the motivation on why one skilled in the art would use the two prior arts to reach the claimed invention, when there is clearly no connection between the two. In fact, its bizarre to suggest using prepaid cards/gift certificates which values increases from time to time randomly as it will surely bankrupt the telco providing such services.

20 The appellant respectfully ask these claims to be allowed.

Claims 33,38,43

25 These claims state the payer is unknown to said host server. At first glance the applicant is unable to decipher whether the examiner has provided any rejection for this element. On second glance, the examiner noted in item B at page 4 with the words " since the

system only asks payer to enter ID and password, password true identity (name, address and birth date) is not known to the system in response to “prompting payer to input payer’s account identifier and password” element found in Claim 13,34,39.

- 5 With respect, this type of rejection is unclear and it appears to be a conclusion in reading col 17, lines 50-51 in Katz which states “If the caller ID information is not available in decision 402, a step 403 prompts the caller to input their subscriber ID and PIN.”

- By way of a background, a telephony system usually provides caller ID on demand
10 (appears on the telephone LCD) when caller ID is used but obviously this caller ID would not be available when the user provides a computer to access the system or any device that does not go through telephone exchange able to transmit this caller ID. That is the reason for Katz to teach asking for subscriber ID and PIN. However, does this mean by asking subscriber ID and PIN, the subscriber is unknown to the host server ? Note that
15 subscriber ID is denoted as telephone number (Col 7 line 6). This is tantamount to saying the telephony operator has no record of its customers’ identities which is difficult to believe.

- The applicant would respectfully argued that since Katz uses a system that is integrated to
20 prepaid telephony platform and have access to its database 173 (See Col 9 line 5 to line 25 and Fig 3A) and hence these subscribers in said database 344 are subscribers to said telephony platform 170, it is very unlikely these subscribers are unknown to the telephony service provider 170. The fact that a service is prepaid does not mean the telephone company does not ask for identification when opening an telephone account,
25 nor is this a known practice.

Even non-subscribers will be allocated a temporary subscriber ID for a specific transaction. (See Col 7 line 29). Furthermore, when it comes to redeeming its unit-

minute, Katz teach of the option of sending it to a bank account (Col 8 line 1-5) for payee. Surely, at this stage the UMS 340 must know to whom the money must be credited to based on the bank account information, As far as ACH is concerned, the bank account must tally with the name of payer/payee or the transaction will fail. Therefore, the applicant respectfully submits that unless there is clear evidence to support the examiner's conclusion that a telco's database or its sidekick Katz database are inept in identifying its customers, then these claims must be allowed.

10 Claims 44,45,46

These claims deals with issuance of a receipt representative a prepaid card having at least a serial number by a POS connected to said server. To clarify, these claims are directed to a user purchasing a prepaid card at POS and which also issues a receipt representative of said prepaid card. User therefore receives a receipt plus a prepaid card. This is in case the user lost the prepaid card, he could still use it by referring to the receipt which bears a serial number connected to said prepaid card to cancel the card if the amount is still 'floating' (ie before storing it).

20 The examiner provided Item K & L at page 6 to show obviousness. The evidence in Katz as suggested by the examiner to be found at Col 7, lines 63, col 8 lines 2 and 15 and col 19 lines 17-24.

To restate these evidence, the applicant quotes the whole paragraph encompassing col 7, line 63 to col 8 line 15 for completeness as follows: "In a preferred embodiment, the system and method of the invention also provides a method for subscribers to access their

"minute account" from any ATM or retail point-of-sale, POS terminal. In this method, the subscriber is issued a debit card associated with their prepaid minute account. This debit card is configured and functions in the same manner as traditional checking account based debit cards, except that in this case, withdrawals trigger a reduction of unit-minutes equivalent to the value of withdrawal. Integration between the system and POS/ATM networks requires that the system and its associated corporate owner become a member bank within the financial network. Membership typically entails meeting certain network guidelines concerning credit worthiness and financial liquidity. In addition such memberships usually entail that the member becomes a governmentally registered and regulated bank. In an embodiment where a non-financial network member implements the invention, it may be advantageous to partner with an existing financial network member. In this method of integration, the system's financial network interface would interface with the backend computer systems of the financial partner instead of directly with the financial networks."

The applicant respectfully submits that the above only shows POS being accessed by a debit card to check minute account. There is nothing to show printing a receipt representative of a prepaid card.

As for Col 19 lines 17-24, this is stated as follows: "Once this has been determined, UMACH 370 will send a message via UMACH TP interface 371 to bank computer system 377 requesting that it issue appropriate payment requests, via interbank financial network 365, to all members who owe unit-minutes to UMACH 370 network. This payment request is in the form of the currency equivalent of the owed unit-minutes and is directed to be made to a UMACH settlement account 385."

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

The examiner also reasoned “ Sending receipt to both the sender and receiver. This message may be sent in a number of formats.....facsimile message (Print) or text..., containing account/transaction ID”

- 5 It is clear the examiner is desperately trying to combine two different stages in Katz’s teachings, the first being to access minute account using a POS and the second UMACH performing a reconciliation between members’ unit minute accounts (similar to ACH) in sending receipts. Not only such combination is illogical, but the claimed invention also requires “...receipt representative of the prepaid card having at least a serial number”
- 10 which is not found in Katz. It is clear the receipt in Katz contains “account/transaction ID” for a past transaction while this claimed receipt represents at least a serial number of the prepaid card. As mentioned, the purchase of a prepaid card is used to load money into the system, hence a receipt is issued when a prepaid card is purchased (prior to any loading or transfer). This is in contrast to “account/transaction ID” of a past transfer of
- 15 funds in Katz where the claimed receipt merely represents details of the prepaid card in anticipation of a future transaction which is not taught by Katz.

The applicant respectfully ask the claims to be allowed.

20

Claims 48,49

The examiner provided no mention directly to the elements found in both claimed invention.

25

In particularly, these are addition elements over claim 13,34,39 includes :

A. ...having a payer created identifier different from source of funds;

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Bstored funds deposited without using a bank account;

Cwhereby payer and payee are two different persons.

5 As for A, the applicant submits that Katz fails to show this as the subscriber identifier is a phone number (Col 7 line 6), it is unknown in the art whereby such telephone number is created by subscriber himself. (contrast from choosing or given a number by telco).

10 As for B, the applicant submits that Katz teaches depositing using a bank account (Col 13 line 52, Col 15 line 55- Col 16 line 30). Katz also provides using a credit card to purchase prepaid minutes. And even if all kind of funding facilities could be used including a prepaid calling card, one still must remember Katz teaches a telephony platform which must necessarily means its value must be stored as prepaid minutes and NOT stored funds.

15 As for C, Katz also teach subscriber redeeming the unit-minutes himself which means it could be the same payer and payee even though in general the applicant concedes, the payer subscriber and payee subscriber should be different persons.

20 Hence as far as A and B are concerned, the applicant submits Katz fails to show the elements and hence 103(a) was not made out by the examiner. As mentioned previously, the examiner also failed to address the issue of payer created identifier different from the source of funds. For the same reasons, these claims should be in allowance.

Claims 50,51,52

25

The examiner provided no mention of them based on the amendment in 22 July 2007 and in this current rejection mailed July 9 2008. In fact, the appellant believed the examiner has used the old rejection as in Item M at page 6. Obviously Katz fails to show this as it

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

teaches a prepaid calling card to make telephone calls. It is also well known that a credit or debit cards are NOT cash card. Similarly, the applicant respectfully ask these claims to be allowed.

5

Much Obliged,

10

A handwritten signature in black ink, appearing to be 'KHAI KWAN', written in a stylized, cursive-like font.

Khai Kwan

Appellant/Applicant

15

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Appendix

Text of Claims as per this Appeal.

5

13. In an Internet system having a plurality of computers connected by a network, a user to user payment method executable at a host server having a database to transfer stored funds in any currencies over a network under payer's control, comprising:

10 prompting payer to input payer's account identifier and password;

 authenticating the payer's account identifier and password for validity;

 prompting the payer to input payee's account identifier and fund transfer information;

15

 receiving said payee's account identifier and said fund transfer information;

 upon authenticating the payee's account identifier, instantly crediting the fund to the payee's account upon determining balance in the database associated with the payer

20

account identifier and password is more than the fund for transfer;

 instantly debiting the balance associated with the payer's account identifier and password in the database with said fund transferred to said payee's account;

25

whereby said stored fund is deposited from a prepaid card into an account linked to an user created identifier; and

whereby said transfer is made without interacting with said payee and independently of said prepaid card.

- 5 14. The method of Claim 13 includes a step of storing and linking prepaid card amount to an user account identifier in the host server over a network comprising:

prompting user to enter security code associated with the prepaid card;

- 10 receiving the security code;

determining the security code is valid;

determining any account **identifier** is associated with the security code;

15

upon determining there is no account identifier associated with said code then prompt said user to enter an user account identifier, password, storage period and currency to be stored;

- 20 receiving said user account identifier, password, storage period and currency as inputted by said user;

determining said user account identifier and password for uniqueness against other stored user account identifiers and passwords;

25

calculating stored value;

output the stored value to said user;

upon determining said user account identifier, password combination is unique and the stored value is acceptable to said user then add said account identifier and password into database linked with the stored value amount;

5

upon determining said user account identifier, password combination is not unique and stored value is acceptable to said user then linked the stored value amount to said existing user account identifier and password in the database; and

10 whereby upon completion of storing and linking said prepaid card is valueless.

26. The method according to Claim 14, wherein calculation of the stored value is based at least in part on the formula below:

15

Stored value = $B * D * L * C * R$

Where B is face value of the prepaid card or floating balance whichever is less, D is a factor related to storage period, L is a factor related to value and loyalty of customer that is based on his/her past purchases of pre-paid cards, C is a factor related to cost of money and R is a factor related to flexibility in currency stored.

20

33. The method according to Claim 13 whereby said payer is unknown to said host server

.

25

34. An Internet system for user to user fund transfer over a network comprising:

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

a host server having a database to transfer stored funds in any currencies under payer's control, wherein said server having a processor to execute program codes stored in a computer storage medium; and , wherein the program codes, further comprises:

5 code to prompt payer to input payer's account identifier and password;

code to authenticate the payer's account identifier and password for validity;

code to prompt the payer to input payee's account identifier and fund transfer
10 information;

code to receiving said payee's account identifier and said fund transfer information;

code to authenticate the payee's account identifier and upon authentication, instantly
15 crediting the fund to the payee's account upon determining balance in the database associated with the payer account identifier and password is more than the fund for transfer;

code to instantly debiting the balance associated with the payer's account identifier and
20 password in the database with said fund transferred to said payee's account;

whereby said stored fund is deposited from a prepaid card into an account linked to an user created identifier; and

25 whereby said transfer is made without interacting with said payee and independently of said prepaid card.

35. The system of claim 34 wherein program code further comprising:

code to prompt user to enter security code associated with the prepaid card;

5 code to receive the security code;

code to determine the security code is valid;

code to determine any account identifier is associated with the security code;

10

code to prompt said user to enter an user account identifier, password, storage period and currency to be stored upon determining there is no account identifier associated with said security code;

15 code to receive said user account identifier, password, storage period and currency as inputted by said user;

code to determine said user account identifier and password for uniqueness against other stored user account identifiers and passwords;

20

code to calculate stored value;

code to output the stored value to said user;

25 code to add said account identifier and password into database linked with the stored value upon determining said user account identifier, password combination is unique and the stored value is acceptable to said user;

code to link the stored value to said existing user account identifier and password in the database upon determining said user account identifier, password combination is not unique and stored value is acceptable to said user; and

5 whereby upon completion of storing and linking said prepaid card is valueless.

36. The system of claim 35 wherein code to calculate the stored value is based at least in part on the formula below:

10 $\text{Stored value} = B * D * L * C * R$

Where B is face value of the prepaid card or floating balance whichever is less, D is a factor related to storage period, L is a factor related to value and loyalty of customer that is based on his/her past purchases of pre-paid cards, C is a factor related to cost of money
15 and R is a factor related to flexibility in currency stored.

38. The system according to Claim 34 whereby said payer is unknown to said host server.

20 39. Computer executable software code stored on a computer readable storage medium, said codes when executed causing a host server having a database to transfer stored funds between users in any currencies over a network under payer's control comprising :

code to prompt payer to input payer's account identifier and password;

25

code to authenticate the payer's account identifier and password for validity;

code to prompt the payer to input payee's account identifier and fund transfer information;

code to receiving said payee's account identifier and said fund transfer information;

5

code to authenticate the payee's account identifier and upon authentication, instantly crediting the fund to the payee's account upon determining balance in the database associated with the payer account identifier and password is more than the fund for transfer;

10

code to instantly debiting the balance associated with the payer's account identifier and password in the database with said fund transferred to said payee's account;

whereby said stored fund is deposited from a prepaid card into an account linked to an user created identifier; and

15

whereby said transfer is made without interacting with said payee and independently of said prepaid card.

20 40. According to Claim 39 wherein said software code further comprising :

code to prompt user to enter security code associated with the prepaid card;

code to receive the security code;

25

code to determine the security code is valid;

code to determine any account identifier is associated with the security code;

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

code to prompt said user to enter an user account identifier, password, storage period and currency to be stored upon determining there is no account identifier associated with said security code;

5

code to receive said user account identifier, password, storage period and currency as inputted by said user;

code to determine said user account identifier and password for uniqueness against other stored user account identifiers and passwords;

10

code to calculate stored value;

code to output the stored value to said user;

15

code to add said account identifier and password into database linked with the stored value upon determining said user account identifier, password combination is unique and the stored value is acceptable to said user;

code to link the stored value to said existing user account identifier and password in the database upon determining said user account identifier, password combination is not unique and stored value is acceptable to said user; and

20

whereby upon completion of storing and linking said prepaid card is valueless.

25

41. According to Claim 40 wherein said code to calculate the stored value is based at least in part on the formula below:

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Stored value = $B * D * L * C * R$

Where B is face value of the prepaid card or floating balance whichever is less, D is a factor related to storage period, L is a factor related to value and loyalty of customer that
5 is based on his/her past purchases of pre-paid cards, C is a factor related to cost of money and R is a factor related to flexibility in currency stored.

10 43. According to Claim 39 whereby said payer is unknown to said host server.

44. The method of Claim 13 includes providing at least one point of sale terminal adapted to issue by printing a receipt representative of the prepaid card having at least a serial number .

15 45. The system of Claim 34 includes at least one point of sale terminal adapted to issue by printing a receipt representative of the prepaid card having at least a serial number .

46. According to Claim 39 wherein said software code further comprising :
20 code to enable at least one point of sale terminal to be connected to said host server to issue by printing a receipt representative of the prepaid card having at least a serial number.

25 48. A computer based method for person to person instantaneous fund transfer, the method comprising :

providing a host server having a database to transfer stored funds;

using said stored funds in payer's account for transfer to payee whereby said account having a payer created identifier being different from source of funds;

submitting said identifier for verification prior to a transfer and said transfer is
5 instantaneously without interacting with said source of funds and said payee;

whereby said stored funds is deposited without using said payer's bank account; and

whereby said payer and said payee are two different persons.

10

49. A system for person to person instantaneous fund transfer, the system comprising :

a host server having a database to transfer stored funds , wherein said server having a processor to execute program codes stored in a computer storage medium; and

15

wherein the program codes, further comprises:

code to transfer said stored funds in payer's account to payee whereby said account having a payer created identifier being different to source of funds;

20

code to submit said identifier for verification prior to transfer and said transfer is instantaneously without interacting with said source of funds and said payee;

whereby said stored funds is deposited without using said payer's bank account; and

25

whereby said payer and said payee are two different persons.

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

50. The method according to Claim 13 whereby said prepaid card is a cash card .
51. According to Claim 34 whereby said prepaid card is a cash card.
- 5 52. According to Claim 39 whereby said prepaid card is a cash card.

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Evidence Appendix

NONE

Application number: 09/396005

Art Unit: 3621

Applicant: Khai Hee Kwan

Examiner: Evens Augustin

Title: Method, apparatus and program to make payment in any currencies through a communication network system using prepaid cards

Related Proceedings Appendix

NONE